



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,268	12/15/2000	Karen B. Chapman	P 0276580 23523-0169	8120
909	7590	11/14/2003	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			LAMBERTSON, DAVID A	
			ART UNIT	PAPER NUMBER

1636

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/736,268	Applicant(s) CHAPMAN, KAREN B.	
	Examiner David A. Lambertson	Art Unit 1636	

--Th MAILING DATE of this communication appears on the cov r she t with the correspond nc address --

THE REPLY FILED 23 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-16, 26-32 and 36-53.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


JAMES KETTER
PRIMARY EXAMINER

Continuation of 2. NOTE: As it regards section 2(a), the After Final amendment to the claims introduces new limitations that would require a new search and consideration after prosecution on the merits has been closed. Specifically, there was previously no limitation in the claims that indicated the reprogramming of a somatic cell nucleus alone, as opposed to the previous claims which indicated the reprogramming of a complete cell. This limitation would obviate a need for some of the somatic cell cytoplasm being present, and could result in the application of new art and written description/enablement rejections.

As it regards section 2(b) above, the claims as indicated in the After Final amendment contain claims that were not present at the time of Final Rejection (claims 17-25 and 33-35). First, these claims were indicated as cancelled in a previous rejection (the response filed February 13, 2003), and cannot be re-introduced. Second, the claims as they stand in the After Final amendment are completely different from claims 17-25 and 33-35 as they stood prior to their cancellation; therefore, these claims introduce new matter into the specification, especially since there is no support in the specification for the limitations set forth in the claims.

Finally, as it regards section 2(c), the After Final amendment does not place the application in better form of appeal because it raises new issues that were not addressed during prosecution on the merits, it attempts to re-introduce claims that were previously cancelled, and it attempts to add new matter into the specification and the claims.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments are predicated on the entry of the After Final amendment, which has not been entered. Therefore, applicant's request for reconsideration is moot.